

### **Remarks**

Applicant respectfully requests favorable reconsideration of the present application in view of the amendments and remarks set forth herein. Applicant appreciates the Examiner's examination of this application and the indicated allowability of claims 3-14, 17-21 and 24.

Applicant has amended claims 22, 27 and 29 and respectfully asserts these claims are allowable as presented herein.

Claims 25, 26, 28 and 34-37 are canceled.

### **Claim Rejections under 35 U.S.C. § 112**

On page 2 of the Office Action the Examiner states a claim rejection under 35 U.S.C. § 112 for claim 25. Claim 25 has been amended to clarify the support provided by the extension.

### **Claim Rejections under 35 U.S.C. § 102**

Claim 22 has been amended to include an element of a foot providing the support for the extension. Claims 25, 26, 28 and 34-37 are cancelled.

### **Claim Rejections under 35 U.S.C. § 103**

On page 3 of the Office Action, the Examiner states that claim 31-33 are rejected under 35 U.S.C. § 103, as being unpatentable over Webster et al in view of Roberts.

Claims 31-33 have been amended to include the elements of claims 25 and 30. Applicant asserts that the rejection stated under 35 U.S.C. § 103 is improper and respectfully requests the Examiner to withdraw this rejection.

Numerous cases which have been decided by the Federal Circuit state the proposition that there must be a teaching or suggestion in the cited references to modify them as suggested by the Examiner. See, for example, Ben W. Vandenberg et al. v. Dairy Equipment Co., 224 USPQ 195 (Fed. Cir. 1984).

The issue of obviousness or non-obviousness was discussed in an opinion of the Federal Circuit entitled Orthopedic Equipment Co., Inc. v. U.S., 217 USPQ 193 (Fed. Cir. 1983). The Federal Circuit noted that the question of non-obviousness is a simple one to ask, but difficult to answer. There the Court was confronted with a situation in which the prior art showed each of

the elements of the disputed claims. The question, the Court said, becomes whether it would have been obvious to a person of ordinary skill in the art to "coordinate" these elements in the same manner as the disputed claims. In cautioning against the use of hindsight in answering this question, the Court stated at page 199:

"The difficulty which attaches to all honest attempts to answer this question can be attributed to the strong temptation to rely on hindsight while undertaking this evaluation. It is wrong to use the patent in suit as a guide through the maze of prior art references in the right way so as to achieve the result of the claims in suit. Monday morning quarterbacking is quite improper when resolving the question of non-obviousness in a court of law".

In In re Rijckaert, 28 USPQ2d 1955 (CAFC 1993) the Court of Appeals outlined the burden on the Patent and Trademark Office as follows:

"In rejecting claims under 35 U.S.C.  $\S$  103, the Examiner bears the initial burden of presenting a *prima facie* case of obviousness. In *re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). Only if that burden is met, does the burden of coming forward with evidence or argument shift to the applicant. *Id.* "A *prima facie* case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art." *In re Bell*, 991 F.2d 781, 782, 26 USPQ2d 1529, 1531, (Fed. Cir. 1993) (quoting in *re Rinehart*, 531 F. 2d 1048, 1-51, 189 USPQ 143, 147, (CCPA 1976)). If the Examiner fails to establish a *prima facie* case, the rejection is improper and will be overturned. *In re Fine*, 837 F. 2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988)."

There is no objective teaching in Webster et al. in view of Roberts to suggest that a the servers of Webster should be substituted with the servers disclosed in Roberts. Only Applicant's specification and drawings provide that teaching.

The Federal Circuit also gave additional guidance when rejecting claims as obvious over a combination of prior art references. The Court in In re Dembiczak, 50 USPQ2d 1614 (1999) reversed a rejection of claims as obvious over a combination of prior art references. The Court stated at page 1616:

"Our analysis begins in the text of section 103 quoted above, with the phrase "at the time the invention was made." For it is this phrase that guards against entry into the "tempting but forbidden

zone of hindsight," see *Loctite Corp. v. Ultraseal, Ltd.*, 781 F. 2d 861, 873, 228, USPQ 90, 98, (Fed. Cir. 1985), overruled on other grounds by *Nobelpharma AB v. Implant Innovations, Inc.*, 141 F.3d 1059, 46 USPQ2d 1097 (Fed. Cir. 1998), when analyzing the patentability of claims pursuant to that section. Measuring a claimed invention against the standard established by section 103 requires the oft-difficult but critical step of casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. See e.g., *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 313, (Fed. Cir. 1983). Close adherence to this methodology is especially important in the case of less technologically complex inventions, where the very ease with which the invention can be understood may prompt one "to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher". *Id.*

Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references. See, e.g. *C.R. Bard, Inc. v. M3 Sys., Inc.*, 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232, (Fed. Cir. 1998) (describing "teaching or suggestion or motivation [to combine]" as an "essential evidentiary component of an obviousness holding"); *In re Rouffet*, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998) ("the Board must identify specifically.... the reasons one of ordinary skill in the art would have been motivated to select the references and combine them"); *In re Fritch*, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783, (Fed. Cir. 1992) (examiner can satisfy burden of obviousness in light of combination "only by showing some objective teaching [leading to the combination]"); *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988) (evidence of teaching or suggestion "essential" to avoid hindsight); *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.* 776 F.2d 281, 297, 227 USPQ 657, 667 (Fed. Cir. 1985) (district court's conclusion of obviousness was error when it "did not elucidate any factual teachings, suggestions or incentives from this prior art that showed the propriety of combination"). See also *Graham*, 3838 U.S. at 18, 148 USPQ at 467 ("strict observance" of factual predicates to obviousness conclusion required). Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability - the essence of hindsight. See, e.g., *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1138, 227 USPQ 543, 547 (Fed. Cir. 1985) ("The invention

must be viewed not with the blueprint drawn by the inventor, but in the state of the art that existed at the time."). In this case, the Board fell into the hindsight trap.

Also see Ecolchem, Inc. v. Southern California Edison Company 227 F.3d 1361 (Fed. Cir. 2000) which held at page 1375 that:

"However, there still must be evidence that "a skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed."

In re Rouffet, 149 F.3d at 1357, 47 USPQ2d at 1456; see also In re Werner Kotzab, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) ("[A] rejection cannot be predicated on the mere identification....of individual components of claimed limitations. Rather, particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed.") Here, there was no such evidence presented."

For all of the reasons outlined above, the rejection of the claims 31-33 at currently amended is unfounded since it does not properly account for and establish the obviousness of the claimed subject matter as a whole. Where the Office Action fails to establish a prima facie case, the rejection is improper and will be overturned. In re Fine, 837F.2d 1071, 1074, 5 USPQ 2d 1596, 1598 (Fed. Cir. 1988).

### **Conclusion**

Applicant asserts the amended claims presented herein are in condition for allowance and respectfully requests favorable reconsideration of this application.

*Application No.: 10/682,642*

The Commissioner is authorized to charge any deficiencies or credit any overpayments to Deposit Account number 12-0913 with reference to our attorney docket number 27726-94930.

Respectfully submitted,  
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Date: August 8, 2006